

REMARKS

This responds to the Office Action mailed on August 25, 2005, and the references cited therewith.

Claims 1, 12, 14, 25 and 36 are amended, no claims are canceled or added; as a result, claims 1-37 remain pending in this application.

Drawings

Replacement drawing sheets for Figures 1-17 are submitted with this response. The replacement drawing sheets correct informalities, no other changes to the figures have been made.

§ 101 Rejection of the Claims

Claims 1-13 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action correctly states that claims 1-13 produce a useful, concrete and tangible result. However, the Office Action further states that the claims were not statutory under 35 USC § 101 because claims 1-13 are "not within the technological arts." Applicant respectfully traverses the rejection.

The Board of Patent Appeals recently stated that there is no judicially recognized separate "technological arts" test to determine patent eligible subject matter under Section 101. *Ex parte Carl A. Lundgren*, Appeal No. 2003-2088, October 18, 2005. Instead, the test the Office must use with respect to Section 101 is whether the claim as a whole produces a useful, concrete and tangible result. It has long been established that software implementations including programs and codes embodied in a computer media are inventions that are entitled to patent protection and thus are considered patentable subject matter. (*In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (*en banc*)). In fact, if a claimed invention as a whole produces a useful concrete and tangible result, then the invention is patentable. (*State Street Bank & Trust v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998).

In view of the above, Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1-13.

§112 Rejection of the Claims

Claims 12 and 36 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicant has amended claims 12 and 36 in order to provide the requested clarification. In particular, claims 12 and 36 have been amended to clarify that a first itinerary may be used as a basis for a second itinerary by supplying data to be used for the second itinerary. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 12 and 36.

§102 Rejection of the Claims

Claims 1-3, 5-10, 13-15, 18-23, 24-27, 29-34 and 37 were rejected under 35 U.S.C. § 102(b) for anticipation by Flake et al. (US 5,832,451). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that Flake does not anticipate the claims as amended because the claims contain elements not found in Flake.

For example, claims 1 and 25 as amended each recite "receiving data from a client system to insert into a traveler database having traveler information." Claim 14 as amended recites similar language. Applicant has reviewed Flake and can find no disclosure that data may be received from a client system to insert into a traveler database. As a result, claims 1, 14 and 25 contain elements not found in Flake. Thus Flake does not anticipate claims 1, 14 and 25 as amended. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 14 and 25.

Claims 2-3, 5-10, and 13 depend either directly or indirectly from claim 1; claims 15, 18-23, and 24 depend either directly or indirectly from claim 14 and claims 26-27, 29-34 and 37 depend either directly or indirectly from claim 25. These dependent claims therefore inherit the

elements of the respective base claims, including the elements related to receiving data from a client system to insert into a traveler database. As discussed above, Flake does not teach or suggest such an element. As a result, Flake does not anticipate claims 2-3, 5-10, 13, 15, 18-24, 26-27, 29-34 and 37. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-3, 5-10, 13, 15, 18-24, 26-27, 29-34 and 37.

§103 Rejection of the Claims

Claims 4 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake et al. (US 5,832,451) in view of Bull et al. (US 5,995,943).

Claims 11, 12, 35 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake et al. (US 5,832,451) in view of Iyengar et al. (US 6,360,205).

Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake et al. (US 5,832,451) in view of Lynch et al. (US 6,119,094).

In order for a *prima facie* case of obviousness under 35 U.S.C. § 103 to exist, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the cited references do not teach or suggest all the limitations in Applicant's claims as amended.

Claims 4, 11 and 12 depend either directly or indirectly from claim 1; claims 16 and 17 depend either directly or indirectly from claim 14; and claims 28, 35 and 36 depend either directly or indirectly from claim 25. These dependent claims therefore inherit from their respective base claims elements directed to receiving data from a client system for populating a traveler database system. As discussed above, Flake does not teach or suggest such an element. Additionally, Applicant has reviewed Bull, Iyengar and Lynch and can find no teaching or suggestion of populating a traveler database with data from a client system. As a result, Flake, in

combination with any of Bull, Iyengar or Lynch does not teach or suggest all of the claim limitations of claims 4, 11-12, 16-17, 28 and 35-36. As a result, the claims are not obvious in view of the combination of Flake with Bull, Iyengar or Lynch. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 4, 11-12, 16-17, 28 and 35-36.

Additionally, with respect to claims 12 and 36, the Office Action admits that neither Flake nor Iyengar teach or suggest "retrieving data regarding a co-traveler and further comprising copying the data regarding the co-traveler's itinerary into a current traveler's itinerary." However, the Office Action goes on to state that "it would have been obvious to one of ordinary skill in the art at the time of the invention to store another companion's previous travel record to copy the data into the traveler's new itinerary." Applicant respectfully traverses this assertion. The Office Action provides absolutely no support for this assertion, either in the form of a reference or by taking Official Notice of the elements that the Office Action admits are not taught or suggested by the combination of Flake and Iyengar. If the Examiner intended to take Official Notice of the missing elements, Applicant respectfully traverses this Official Notice and requests the Examiner to provide a reference that describes missing elements. Alternatively, absent a reference, it appears that the Examiner is using personal knowledge, and the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

GREG UDELHOVEN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

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By



Rodney L. Lacy
Reg. No. 41,136

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